

REMARKS/ARGUMENTS

This Amendment is being submitted in response to the Office Action dated June 27, 2005. Claims 1-7, 9-18, and 20-23 are pending in the present application. Claims 1-7, 9-12, 14, 18, 20 and 23 have been amended. Claims 1-7, 9-18, and 20-23 remain pending.

The claims have been amended to replace all occurrences of “hand-held digital imaging device” with “digital camera,” which renders the claim objections to claims 1, 12 and 23 moot. Support for the amendments can be found throughout the application, and in particular on page 10, lines 1-3 of the originally filed specification. Accordingly, it is respectfully submitted that no new matter has been entered.

§103 Rejections

The Examiner rejected claims 1-7, 9-18, and 20-23 under 35 USC §103(a) as being unpatentable over Chui et al. (US 6,657,702) in view of Kojima et al. (US2004/0174440). Applicants respectfully disagree.

Chui discloses a print generation and distribution system that enables users to transmit images to a photo-finisher and then order prints of those images to be sent to one or more recipients. The system has a web front-end computer system connected to a network, such as the Internet, for communicating with customers (col. 10, lines 41-55). The computer system displays a graphical user interface (e.g., web pages) that users interact with through a web browser (col. 15, lines 31-47). Before the user can order prints, the user's images first are transmitted to the photo-finisher (col. 12, lines 39-40). After the user's images have reached the photo-finisher and have been made available online, the user can place an order with the photo-finisher (col. 14, lines 47-49). One way to place an order is by having the user view the images online with a

browser and selectively designate which images should be printed. The user also will specify one or more recipients to whom prints should be distributed and, further, print parameters for each of the individual recipients, such as the size, number of copies and print finish, and also custom messages to be printed on the back or front of a print (col. 14, lines 47-55). After the images and recipients and respective parameters have been specified, the user's order is fulfilled by making prints of the designated images and distributing them to the specified recipients (col. 14, lines 66-col. 15, line 2).

The Examiner cited Chui for disclosing all the limitations of claim 1 except for teaching a hand-held image capture device. The Examiner cited Kojima for teaching a hand-held image capture device that comprises the digital camera and a notebook computer. The Examiner stated that "it would have been obvious to one of ordinary skill in the art to combine the teachings of Chui and Kojima to implement a hand-held image capture device having all features and functions equivalent to the combined digital camera and computer in Chui ... for capturing images and ordering online services."

Applicants respectfully submit that a combination of Chui and Kojima fails to teach or suggest all of the elements of the amended claims of the present invention. First, the combination fails to teach or suggest "after the user selects at least one of the items in the action list, sending the images and the selected action list item from the digital camera to the server," as recited in claims 1, 12, and 23 (emphasis added). As discussed above, Chui describes that before the user can order prints, the user's images first are transmitted to the photo-finisher (col. 12, lines 39-40). Chui then describes that after the user's images have reached the photo-finisher and have been made available online, the user can place an order with the photo-finisher (col. 14, lines 47-49). These passages make clear that any parameters associated with placing a

print order are sent to Chui's web front-end computer system separately from the images to be printed. Nowhere does Kojima describe or suggest the uploading of images for ordering prints (or any other purpose for that matter), thus Kojima cannot cure the deficiency of Chui. Accordingly, claims 1, 12, and 23 are considered allowable over the cited combination for at least this reason.

Second, the Chui/Kojima combination fails to teach or suggest "downloading an action list from the server to the digital camera, the action list including one or more items representing actions that the server should take with respect to uploaded images" as recited in claims 1, 12, and 23. The Examiner asserts that Chui discloses downloading a list of actions with their picture delivery bar, as described at column 15 et seq. But Chui's picture delivery bar is not an action list as the Examiner asserts. Instead, Chui's picture delivery bar allows a user to specify parameters for an already initiated action—ordering prints. The picture delivery bar allows users to specify the recipients of a print order and their addresses, but these are only parameters of the print order, not separate action items as the claims require. Accordingly, claims 1, 12, and 23 are considered allowable over the cited combination for this reason as well.

Not only does the Chui/Kojima combination fail to teach or suggest all of the elements of the claims, Applicants also respectfully submit that the Chui/Kojima combination is improper because there is a lack of motivation to combine the references. "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention *where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.*" MPEP 2143.01. "The mere fact that references can be combined or modify

does not render the resultant combination obvious *unless the prior art also suggests the desirability of the combination.*" MPEP 2143.01. "[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." MPEP 2142.

Here, none of the references teach or suggest combining the references to disclose a digital camera that operates as recited in amended claims 1, 12, and 23. In combining Kojima—a reference that describes a notebook computer having a mounted CCD video camera—with the base reference Chiu, it seems that the Examiner is basing his rejection on the assumption that once an image capture device (or a digital camera as now recited in the amended claims) is provided with computer functionality, the solution to the problem being solved by the claimed invention would be obvious to one of ordinary skill in the computer or computer programming arts.

Applicants assert, however, that the person of ordinary skill in the art is not a computer programmer, but rather a traditional camera manufacturer. Applicants assert that at the time of the invention, it would not have occurred to a camera manufacturer (or a skilled programmer) to provide a digital camera with the function of the claimed invention. Indeed, network-enabled digital cameras are just now being introduced into the market—over five years after the filing of this application. Accordingly, persons having ordinary skill in the camera arts at the time of this invention would not have been motivated to combine Kojima with Chiu as the Examiner suggests.

Applicants also assert that Kojima is non-analogous art, further underscoring an absence of the requisite motivation to combine the references. Claims 1, 12, and 23 define methods and apparatus "for allowing a user to select actions to be taken by a server when uploading images from a **digital camera** over a network". The Examiner

admits that Chui fails to teach or suggest a hand-held digital imaging device, and that Kojima's device "comprises both a digital camera and a computer." Thus, by the Examiner's admissions, the combination fails to teach or suggest a digital camera, i.e., a single integrated hand-held device, which is capable of network communication with a server. The claimed device in the present application is a network capable digital camera that a user can easily carry and operate. This is fundamentally different than a notebook computer having a CCD video camera mounted on its display, as taught by Kojima. The increased complexity, size, cost, and power consumption of such a notebook computer as compared to a digital camera are only some of the reasons why consumers do not substitute a notebook computer having a mounted or attached camera for a single digital camera when taking pictures during travel or on other occasions. Thus, Kojima's notebook computer should not be considered analogous to a digital camera. Accordingly, persons having ordinary skill in the camera arts would not have been motivated to combine the non-analogous Kojima reference with the base reference Chiu.

In view of the foregoing, it is submitted that independent claims 1, 12 and 23 are allowable over the cited references. Moreover, the remaining claims, which depend either directly or indirectly from one of claims 1, 12, and 23, are considered allowable for at least these same reasons. Accordingly, Applicant respectfully requests reconsideration and passage to issue of claims 1-7, 9-18, and 20-23 as now presented.

Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

Respectfully submitted,
SAWYER LAW GROUP LLP



October 27, 2005
Date

Stephen G. Sullivan
Attorney for Applicant(s)
Reg. No. 38,329
(650) 493-4540